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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,641	04/15/2004	Scott C. Olive	273402005400	1431
23446 7590 06/19/2009 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661				
EXAMINER				
WONG, JEFFREY KEITH				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/826,641

**Applicant(s)**

OLIVE, SCOTT C.

**Examiner**

Jeffrey K. Wong

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Application***

1. This Office-Action acknowledges the Request for Reconsideration filed on 5/12/2009 and is a response to said request.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22-23, 26-27, 31-37, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al., US PUB 2004/0072607(Thomas)

Regarding Claim 22.

A method for use with a gaming machine, the method comprising the steps of:  
determining whether a game play button of a gaming machine has been actuated by a player(para 50. The desired window is selected by simply touching the screen in an area over the window. The touch screen can be viewed as the game play button in which a player must actuate); initiating a play of a first game in response to determining that the game play button has been actuated(para 27), wherein the play of the first game comprises activating a plurality of pay lines at a cost to the player of only one

wagering unit(para 26. Game play is initiated by inserting a number of coins or playing a number of credits, causing a CPU or game controller (not shown) to activate a number of pay lines corresponding to the number of coins or credits played); determining whether the play of the first game results in a first game award outcome, wherein the first game award outcome comprises a first predefined combination of symbols associated with at least one of the pay line(para 29. Alternatively or additionally, the occurrence of "start-bonus" symbols and/or combination(s) may cause the processor to award coin(s) or credit(s) in the basic game); in response to determining that the play of the first game resulted in the first game award outcome, informing the player that they are entitled to a play of a second game(Abstract. The bonus game is entered upon the occurrence of a special start- bonus game outcome in the basic mode); and initiating a play of the second game in response to determining that said game play button has been actuated after said step of informing(para 50. In one embodiment, an animated "hand" pointer scrolls across the grid and window selection is accomplished by the player depressing a designated "select" button when the hand is pointing to a desired selection. The touch screen can be viewed as the game play button that can also be used for initiating game play in basic mode).

Regarding Claims 23, 27.

The method as claimed in claim 22, further comprising the steps of: determining whether the play of the second game results in a second game award outcome, wherein the second game award outcome comprises a second predefined combination of

symbols associated with at least one of the pay lines(para 4. The bonus game may comprise any type of game, either similar to or completely different from the basic game, which is entered upon the occurrence of a selected event or outcome of the basic game...The '840 application discloses an embodiment wherein the basic game is a reel-type slot machine and the bonus game is a simulated reel-type slot machine implemented on a dot-matrix display.); allowing the player to select at least one of the second predefined combination of symbols(Abstract. In the bonus game, a player selects, one at a time, from an array of windows each associated with a bonus game outcome.); and awarding the player only one of a plurality of prizes based on the at least one of the second predefined combination of symbols selected by the player(Abstract. Credits are awarded based upon which ones of the windows are selected.).

Regarding Claim 26.

A gaming machine comprising a game play button(para 27); and an electronic controller and a memory storage device comprising software, the electronic controller and the memory storage device being arranged such that the electronic controller can process the software, wherein processing of the software by the electronic controller causes the electronic controller to(para 75. The memory unit stores control software, operational instructions and data associated with the video game. It is well known that processors are used for implementing software); determine whether a game play button of the gaming machine has been actuated by a player(para 27);

initiate a play of a first game in response to determining that the game play button has been actuated, wherein the play of the first game comprises activating a plurality of pay lines at a cost to the player of only one wagering unit(para 26); determine whether the play of the first game results in a first game award outcome, wherein the first game award outcome comprises a first predefined combination of symbols associated with at least one of the pay lines(para 29); in response to determining that the play of the first game resulted in the first game award outcome, inform the player that they are entitled to a play of a second game(Abstract); and initiate a play of the second game in response to determining that the game play button has been actuated after said electronic controller has informed the player of entitlement to play a second game(para 50).

#### Regarding Claims 31-33

Thomas discloses wherein the bonus game may comprise any type of game, either similar to or completely different from the basic game, which is entered upon the occurrence of a selected event or outcome of the basic game(para 4).

#### Regarding Claim 34.

A gaming machine having a single wager option, comprising  
a button associated with a base game (para 50. The touch screen is viewed as the button associated with a base game)and a bonus feature game(para 4);  
a credit input mechanism to receive credits(para 26. Game play is initiated by inserting

a number of coins or playing a number of credits. It is also well known in the art that casino machines have credit input mechanism.); and

a controller to initiate the base game in response to actuation of the button if sufficient credits remain to cover the single wager option(para 26. Game play is initiated by inserting a number of coins or playing a number of credits, causing a CPU or game controller (not shown) to activate a number of pay lines corresponding to the number of coins or credits played.), and to initiate the bonus feature game in response to actuation of the button if an award outcome of the base game entitles play of the bonus feature game(Abstract. The bonus game is entered upon the occurrence of a special start-bonus game outcome in the basic mode).

Regarding Claim 35.

The gaming machine as claimed in claim 34, comprising

a video display to display the button, and a touch sensor to sense actuation of the button(para 50).

Regarding Claim 36.

The gaming machine as claimed in claim 35, wherein

the base game comprises a spinning reel game having a plurality of reels and a plurality of pay lines(Abstract), the single wager option activates the plurality of pay lines(para 26), and the video display is to display the plurality of reels(para 26. The slot machine 10 includes a display window 12 through which a player may observe three spinning

reels).

Regarding Claim 37.

The gaming machine as claimed in claim 36, wherein the controller determines an award outcome of the bonus feature game based upon a combination of symbols associated with at least one of the pay lines, receives a selection of at least one of the symbols, and awards one of a plurality of prizes based on the selection(para 29. Alternatively or additionally, the occurrence of "start-bonus" symbols and/or combination(s) may cause the processor to award coin(s) or credit(s) in the basic game).

Regarding Claim 39.

Thomas discloses comprising the step of altering the at least one of the second predefined combination of symbols selected by the player or randomly selected by the gaming machine to reveal information about the one of the plurality of prizes to be awarded to the player (para 51. Upon selection of a selection element, the game controller causes the outcome associated with the selected selection element to be revealed on the display).

Claims 24-25, 28-30, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al., US PUB 2004/0072607(Thomas) as applied to claim 22 above, and further in view of Vancura, US PUB 2004/0219963(Vancura).



Regarding Claims 24, 28.

Thomas failed to disclose comprising the step of causing the gaming machine to randomly select at least one of the second predefined combination of symbols if the player does not selected at least one of the second predefined combination of symbols with a period of time.

However, Vacura discloses of an invention related to casino games and, in particular, to improvements in the methods of playing timed bonus games on an underlying game (para 2) that can be applied to slot machines (para 5) because there exists a continual desire to limit the temporal length of the bonus game, so as to maximize the house advantage and to minimize moneymaking "down time" of the underlying casino gaming device(para 8) where if a bonus timer does expire, then there exists a design and method step choice of the player as to how the gaming is to proceed. In a preferred embodiment described above, the player is simply provided with a random response, and is awarded based on the accuracy of the randomly selected response(para 32). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the timer of Vancura's teachings with Thomas' bonus teachings as means of maximizing the house advantage and minimizing moneymaking "down time" of the underlying casino gaming device as taught by Vancura.

Regarding Claims 25, 29.

Thomas discloses further comprising the step of altering the at least one of the second predefined combination of symbols selected by the player or randomly selected by the

gaming machine to reveal information about the one of the plurality of prizes to be awarded to the player (para 51. Upon selection of a selection element, the game controller causes the outcome associated with the selected selection element to be revealed on the display).

Regarding Claim 30.

Thomas discloses wherein said game play button includes visual indicia informing the player that said game play button is for (1) actuation to initiate play of a base game and (2) actuation to initiate play of a feature game(para 77. The operator interface may comprise any combination of push buttons, joysticks, keypads, touch- screens and the like. The game controller executes control software in the memory according to the player inputs and communicates the resulting video game activity including, for example, text, animations and background graphics to the graphics display.)

Regarding Claim 38, 41.

Vacura discloses of an invention related to casino games and, in particular, to improvements in the methods of playing timed bonus games on an underlying game (para 2) that can be applied to slot machines (para 5) because there exists a continual desire to limit the temporal length of the bonus game, so as to maximize the house advantage and to minimize moneymaking "down time" of the underlying casino gaming device(para 8) where if a bonus timer does expire, then there exists a design and method step choice of the player as to how the gaming is to proceed. In a preferred

embodiment described above, the player is simply provided with a random response, and is awarded based on the accuracy of the randomly selected response(para 32).

### ***Response to Arguments***

3. Applicant's arguments filed 5/12/2009 have been fully considered but they are not persuasive. Applicant alleges:

"Thomas does not teach a method of initiating a play of a first game in response to determining that a game play button has been actuated, and initiating a play of a second game in response to determining that the same game play button has been actuated. The Final Action appears to rely upon Thomas paragraph 27 for a teaching of initiating a play of a first game in response to determining that a button has been actuated and to rely upon Thomas paragraph 50 for a teaching of initiating a play of a second game in response to determining that a button has been actuated.

Applicant respectfully submits that Thomas and paragraphs 27 and 50 in particular do not teach that the same button used to initiate the game of paragraph 27 is the same button used to initiate the game of paragraph 50. In particular, paragraph 27 indicates that "[a]fter activation of the paylines, the reels 14, 16, 18 are set in motion by either pulling a lever 20 or depressing a push button (not shown) on the slot machine 10." However, paragraph 50 states that "an animated 'hand' pointer scrolls across the grid and window selection is accomplished by the player depressing a designated 'select' button when the hand is pointing to a desired selection."

Accordingly, paragraph 27 merely indicates that a push button may be depressed to set

the reels 14,1 6, 18 in motion but does not otherwise identify which button of the slot machine 10 sets the reels in motion. On the other hand, paragraph 50 states a "select" button may be depressed to make a window selection. Thus, paragraphs 27 and 50 do not explicitly teach that the buttons are the same."

The Examiner disagrees. Para 76 teaches "The operator interface 72 may comprise any combination of push buttons, joysticks, keypads, touch-screens and the like" and goes to teach in para 77 wherein "The operator interface 72 comprises a touch-screen electrically coupled to the display 66. Player inputs are provided by touching the touch screen 72 at touch points directly above various "keys" or key outlines or other specified areas on the display 66. The controller 62 may be programmed to display the various "keys" or key outlines (not shown) on the graphics display 66 and to recognize the locations of the "keys," key outlines, or other specified areas of the graphics display 66 according to control software in the ROM memory 68. The "keys" or key outlines, if used, may be displayed both during attract mode and during active play of the game. The "keys" may simulate the appearance of an actual key or may comprise game symbols and/or characters shown on the graphic display 66. For example, in a video game implementation of the JACKPOT PARTY.TM. bonus game, the key outlines may comprise areas of the display 66 on which the bonus game window(s) are displayed." The play button found on the touch screen in order to play either the base or the bonus game can be viewed as the button in which a player is expected to actuate. Furthermore, para 27 of the specification of the Applicant's instant

invention discloses that the single button for initiating game play through its actuation can be that of a touch screen.

"The Final Action has not demonstrated that the button of paragraph 27 and the button of paragraph 50 "must" be the same button. As such, Thomas does not explicitly and/or inherently disclose initiating a play of a first game in response to determining that a game play button has been actuated and initiating a play of a second game in response to determining that said game play button has been actuated. Accordingly, Thomas does not anticipate claims 22-23. Applicant respectfully requests the withdrawal of the present rejection of claims 22-23."

The Examiner disagrees. Discussion of the argument has been addressed above.

"Thomas does not explicitly and/or inherently teach a common game play button to initiate a play of a first game and to initiate a play of a second game. Thus, Thomas does not anticipate claims 26-27."

The Examiner disagrees. Discussion of the argument has been addressed above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey K. Wong whose telephone number is (571)270-3003. The examiner can normally be reached on M-Th 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/  
Supervisory Patent Examiner, Art Unit 3714

JKW